



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,169	02/09/2000	William T. Carden Jr.	35672-164254	3485

26694 7590 01/25/2006

VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20045-9998

EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/501,169	Applicant(s) CARDEN JR., WILLIAM T.	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,26,28-37,39,41-44,46-55,57,59-62,64-73,75 and 79-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25,26,28-36,39,41-44,46-54,57,59-62,64-72,75 and 79-87 is/are rejected.
- 7) ☒ Claim(s) 37,55 and 73 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/2/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 11/2/05.
2. Claims 25, 26, 28 - 37, 39, 41 - 44, 46 - 55, 57, 59 - 62, 64 - 73, 75, and 77 - 87 are pending in the case. Claims 25, 43, and 61 are independent.
3. The rejection of claims 25 - 36, 39 - 42; 43 - 54, 57 - 60; and 61 - 72, 75 - 78 under the judicially created doctrine of obviousness-type double patenting as being unpatentable has been withdrawn upon receipt of a terminal disclaimer.
4. The objection to the claims has been changed as necessitated by amendment.
5. The rejection of claims 25, 26, 28 - 37, 39, 41 - 44, 46 - 55, 57, 59 - 62, 64 - 73, 75, and 77 - 87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite has been changed as necessitated by amendment.
6. The rejection of claims 25, 26, 28 - 36, 39, 41 - 44, 46 - 54, 57, 59 - 62, 64 - 72, 75, and 77 - 87 are rejected under 35 U.S.C. 103(a) as being unpatentable has been changed as necessitated by amendment.

Continued Examination Under 37 CFR 1.114

7. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/2/05 has been entered.

Terminal Disclaimer

8. The terminal disclaimer filed on 11/2/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/576386 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

9. Claims 37, 55 and 73 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 25, 43, and 61 are Markush claims; therefore, it is only necessary to follow one path as set forth in those claims. The path(s) limited by the aforementioned dependent claims may or may not be followed; thus, the aforementioned dependent claims do not fully further limit the parent claim(s) from which they depend. Consequently, no further action on the merits with respect to the dependent claim(s) either in part as a whole will be taken by the Office at this time.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 25, 26, 28 - 37, 39, 41 - 44, 46 - 55, 57, 59 - 62, 64 - 73, 75, and 77 - 87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. **Regarding independent claims 25, 43, and 61**, the metes and bounds of the claims cannot be determined because of the various alternatives presented (use of or-clauses) in the claims. Due to the Markush nature of many of the limitations, the claims are unclear; in addition, some limitations lack antecedent basis depending on what path is taken. Thus, depending on what particular path(s) is/are followed certain limitations and/or depending claims will not be considered further on the merits either as a whole or in part. See the section claim objections above for further clarity regarding treatment of the dependent claims. It should be noted that although specific examples are cited below in order to further expedite prosecution, the following list should not be considered exhaustive.

13. Claim 25 recites the limitation "said decision" in line 26. There is insufficient antecedent basis for this limitation in the claim. All subsequent recitations are also rejected.

14. Claim 25 recites the limitation "said at least one meeting or journal" in line 38. There is insufficient antecedent basis for this limitation in the claim due to the Markush-like nature explained above. All subsequent recitations are also rejected.

15. **Regarding the dependent claims w/in claims 25, 26, 28 - 37, 39, 41 - 44, 46 - 55, 57, 59 - 62, 64 - 73, 75, and 77 - 87**, the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 25, 26, 28 - 36, 39, 41 - 44, 46 - 54, 57, 59 - 62, 64 - 72, 75, and 77 - 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanov (US 5706452 A) and further in view of Leone et al. (US 5745360 A) and Bly et al. (US 5220657 A).

18. **Regarding independent claim 25**, Ivanov teaches that *in order to build a particular workflow application, a designer provides facilities to create, store, access, modify, delete documents and reviews, typically using a database management system. Each logical document and/or review can be implemented using a plurality of physical records. In the current embodiment, a document/review is implemented as a single Lotus Notes document, and all document related operations are provided by the Lotus Notes environment (2) defines the data components in the structure of each document and review. Document 44 stores data components for each role 48 and stage 50 relevant for its particular contents* (Column 16, lines 20 – 31), compare with **receiving a submission at a computer system, wherein said computer system includes at least one database to store a plurality of submissions, and wherein said submission includes at least one of a document, correspondence, a review, scheduling information, or a decision on at least one part of said submission; storing at least one version of said submission in said computer system, wherein**

said at least one version includes said submission or at least one revised version of said submission by said plurality of clients; that *modifications in the review authorizations between the moment the document is submitted and the moment reviews are requested can be reflected in the review process; in this respect, the reviewer list can be computed using the programming language just before notifications are sent out* (Column 6, lines 14 – 19), compare with **inviting at least one reviewer from a list of reviewers to review said submission, where said list of reviewers is maintained by said computer system;** and that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27, lines 15 – 22), compare with **providing access to said submission to at least one reviewer who agrees to review said submission; receiving at least one review of said submission from said at least one reviewer who agrees to review said submission, said received at least one review including at least one of a revised document, correspondence, recommendation, a score, or said decision, wherein when said received at least one review is said decisions said decision is at least one of accepting, rejecting, or requesting at least one revision to said submission; reporting said received at least one review about said submission.**

Ivanov teaches that workflow manager 30 again examines document 44 and its associated reviews 46, and eventually deposits another notification 42 into system mail box 34. The process continues until document 44 is declared reviewed (Column 7, lines

64 – 67), compare with **reporting said one or more reviews about said submission.**

Ivanov also discloses that the prior art teaches that *The IP system is a particular approval/rejection system. It does not allow reviewers to grade documents or to express a degree of confidence in their grading. Such feature is important in systems that rank documents for comparative purposes, like bid evaluation, paper review, project proposal, etc. It also does not allow reviewers to contribute any information to the reviewed document, which is important in cases when earlier reviewers conduct research and publish the results for the use of later reviewers* (Column 4, lines 20 – 28), compare with **receiving a selection decision of whether to include content of at least one version of said submission in at least one meeting or journal; determining said content of at least one version of said submission to publish for said at least one meeting or journal when said selection decision is to include said content; and receiving a selection of submissions from at least one of said plurality of clients wherein said selection includes content of at least one version of said submission to publish for said at least one meeting or journal when said selection decision is to include said content.** Ivanov does not explicitly teach **translating...** However, Leone et al. teach that *the preferred embodiment of the invention is illustrated with regard to a special agent process that converts IBM's non-HTML formatted books created by the IBM BookManager Build process into HTML formatted ones. The special agent process will be called "DITA" herein. DITA is the core component process that produces the HTML formatted topics (both text and link anchors) generated by hypertext links. This provides real-time conversion of the non-*

HTML format to HTML. A hypertext link is the entry point into a discrete portion of a book. Performance considerations led to a design of serving only small discrete chunks, or portions of books, known as "topics", to Web browsers instead of processing the entire book at one time. (Column 5, lines 51 – 64), compare with **translating said submission from one of a plurality of clients from at least one input format to at least one user defined output format, wherein said plurality of clients includes an author of said submission, a reviewer of said submission, a chairperson, or a staff person managing at least one meeting or journal; receiving a submission at a computer system, wherein said receiving said submission includes at least one of (i) receiving a file uploaded to said computer system or (ii) receiving data pertaining to said submission by a browser interface.** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Ivanov with that of Leone et al. because such a combination would allow the users of Ivanov the benefit of *an improved method and means for automatically converting non-HTML text and hypertext links to HTML texts and HTML links in electronically formatted documents for access over communications networks* (Column 1, lines 54 – 58). Neither Ivanov nor Leone et al. explicitly teach **creating a proof of said submission to enable viewing and approval of said submission prior to storing said submission in said computer system.** However, Bly et al. teach that *Job dockets includes drafts of text and illustrations, galleys and page proofs, specifications for design and layout, correspondence, and production schedules. A "job sheet" is often pasted on a docket's cover to identify the job and list its production schedule, e.g., a list of tasks to be*

accomplished, scheduled dates for completion, and individual worker assignments. Job dockets are passed from one worker to another as each job step is completed. Unlike a job docket, however, shared structured data objects are intended to allow several professional users to edit or otherwise work concurrently on the same publication (Column 11, lines 51 – 62), compare with **creating a proof of said submission to enable viewing and approval of said submission prior to storing said submission in said computer system**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Ivanov and Leone et al. with that of Bly et al. because such a combination would allow the users of Ivanov and Leone et al. the benefit of *a representation of a shared structured data object can be used to present information about the activities and status relating to the shared structured data object and its content of a plurality of structured data objects as well as other information affecting or tracking the shared structured data object content* (Column 8, lines 43 – 49).

19. **Regarding dependent claim 26**, Ivanov discloses that the prior art teaches that *The IP system is a particular approval/rejection system. It does not allow reviewers to grade documents or to express a degree of confidence in their grading. Such feature is important in systems that rank documents for comparative purposes, like bid evaluation, paper review, project proposal, etc. It also does not allow reviewers to contribute any information to the reviewed document, which is important in cases when earlier reviewers conduct research and publish the results for the use of later reviewers* (Column 4, lines 20 – 28), compare with **receiving order decisions from at least one**

staff person, wherein said order decisions provide at least an arrangement for content of said at least one version of said submission for said at least one meeting or journal; and determining contents of said at least one meeting or journal based on said order decisions.

20. Regarding dependent claims 28 and 80, Ivanov teaches that *actual notifications sent to inform users of events related to a document are based on notification templates; the notification template to be used is identified for each role by evaluating a programming language expression; the text of the notification is further customized substituting programming language expressions in the template with the result of their evaluation* (Column 6, lines 25 – 32), compare with **said submission includes data in the form of text, images, graphics, or multimedia; providing access to predetermined content of said document when said submission includes said document.**

21. Regarding dependent claim 29, Ivanov teaches that *submission date information (...dat) identifies the time and date when document 44 has been submitted for review* (Column 15, lines 40 – 42), compare with **when said submission includes correspondence, said correspondence includes at least one of information about said author, subject matter of said submission, date and time of said submission, proposed publication dates, proposed presentation dates, or proposed meetings or journals for inclusion.**

22. Regarding dependent claims 30, 32 and 33, Ivanov teaches that *in the second solution, some reviewers do not have the authority to reject a proposal but they can*

argue why the proposal should be approved or rejected. Their comments are passed to higher ranking reviewers who can approve or reject a proposal; earlier reviewers also can dynamically modify the workflow by engaging the higher ranking reviewers who otherwise would not be involved in the review process (Column 26, lines 36 – 43), compare with **said list of reviewers is provided to said computer system by at least one of said plurality of clients, that at least one of said plurality of clients produces said list of reviewers, and that said list of reviewers is based on qualifying criteria, wherein said qualifying criteria includes at least one of (i) a reviewer's area of specialty, (ii) a reviewer's prior review history, (iii) a reviewer's professional associations, (iv) a reviewer's availability, or (v) said author's preference for or against at least one reviewer.**

23. **Regarding dependent claims 31,** Ivanov teaches that *the reviewer list can be computed using the programming language just before notifications are sent out (Column 6, lines 17 – 19), which provide that said computer system produces said list of reviewers.*

24. **Regarding dependent claims 34 and 35,** Ivanov teaches that *some of the features of a workflow application built according to the present invention are: (a) provides different access (security) levels based on user's electronic identity, to protect sensitive information from unauthorized users ... (Column 5, lines 14 – 18), which provide that said computer system requires authentication of identity from at least one of said plurality of clients, and that requiring at least one of identification or authentication.*

25. **Regarding dependent claim 36**, Ivanov teaches that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27, lines 15 – 22), compare with **receiving a revision to said submission, wherein the author of said submission provided said revision based on said received at least one review; and providing said revision to said at least one reviewer for additional review.**

26. **Regarding dependent claim 39**, Ivanov teaches that *FIG. 1 is a high level representation of a networked computer system 20, in particular, a Lotus Notes system. Such system connects a number of personal computers 22 and a number of server computers 24, allowing them to communicate. A user seated in front of personal computer 22 can create, access, modify, and delete data which is shared with other users and resides on server computer 24. Each user has an electronic identity and can communicate with other users via an electronic mail system* (Column 7, lines 23 – 31), which provide that **said plurality of clients access said computer system via at least one of the Internet, an extranet, or an intranet.**

27. **Regarding dependent claim 41**, Ivanov teaches that *workflow manager 30 again examines document 44 and its associated reviews 46, and eventually deposits another notification 42 into system mail box 34. The process continues until document 44 is declared reviewed* (Column 7, lines 64 – 67), compare with **reporting acceptability information compiled from said received at least one review.**

28. **Regarding dependent claims 42 and 79**, Ivanov teaches that *participants do not have to know or select who has to review a document next* (Column 5, lines 32 – 34), compare with **wherein information about at least one of said author or said author and said at least one reviewer who agrees to review said submission are not provided to at least one of said plurality of clients; wherein information about said author and said at least one reviewer who agrees to review said submission are not provided to at least one of said plurality of clients.**

29. **Regarding dependent claim 81**, Ivanov teaches that *Documents and their associated reviews are stored into a database which is permanently monitored by a workflow manager. Reviewers are notified by the workflow manager that a document is ready for their review via electronic mail, and they can review a document in parallel. A rigid OR/AND synchronization schema is hard coded into the system. Although roles and barriers can be added, eliminated, or moved around, the methodology suggested by the IP system lacks flexibility as exemplified below. The IP system is a particular approval/rejection system. It does not allow reviewers to grade documents or to express a degree of confidence in their grading. Such feature is important in systems that rank documents for comparative purposes, like bid evaluation, paper review, project proposal, etc. It also does not allow reviewers to contribute any information to the reviewed document, which is important in cases when earlier reviewers conduct research and publish the results for the use of later reviewers* (Column 4, lines 12 – 28), compare with **publishing predetermined content from said database.**

30. **Regarding claims 43, 44, 46 - 54, 57, 59 - 62, 64 - 72, 75, 77 and 78**, the claims incorporate substantially similar subject matter as claims 25, 26, 28 - 36, 39, 41 and 43, and are rejected along the same rationale.

31. **Regarding dependent claims 82 - 87**, the claims incorporate substantially similar subject matter as claims 79 - 81, and are rejected along the same rationale.

Response to Arguments

32. Applicant's arguments filed 11/2/05 have been fully considered but they are not persuasive.

33. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., enable reviewers to each review all portions of a document) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

34. In response to applicant's arguments that Ivanov does not teach, suggest, or disclose **inviting at least one reviewer from a list of reviewers to review said submission, where said list of reviewers is maintained by said computer system**, it should be noted that Ivanov teaches that *modifications in the review authorizations between the moment the document is submitted and the moment reviews are requested can be reflected in the review process; in this respect, the reviewer list can be computed using the programming language just before notifications are sent out* (Column 6, lines 14 – 19), which is synonymous to **inviting at least one reviewer from a list of**

reviewers to review said submission, where said list of reviewers is maintained by said computer system, as explained above in the rejection to the claims under 35 USC 103(a). The Office has interpreted Ivanov's request for a review as the claimed invention's invite.

35. In response to applicant's arguments that Leone et al. do not teach, suggest, or disclose **translating a document form at least one input format to at least one user defined format**, it should be noted that by applicant's own admission Leone et al. translates a document into HTML format (p28, lines 5 & 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to be well aware that HTML is a user defined format, since the skilled artisan can use HTML code to create and/or modify an HTML document thus defining the format.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH

William F. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
1/23/2006